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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,751	12/20/2001	W. Robert Bishop	IN0291K2GQ1B1C	2109

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SCHERING-PLOUGH CORPORATION  
PATENT DEPARTMENT (K-6-1, 1990)  
2000 GALLOPING HILL ROAD  
KENILWORTH, NJ 07033-0530

EXAMINER

TRUONG, TAMTHOM NGO

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 02/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/026,751

**Applicant(s)**

BISHOP ET AL.

**Examiner**

Tamthom N. Truong

**Art Unit**

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-21 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 13-21 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

Applicants' election with traverse the species of Example 410-S in paper no. 10 is acknowledged. Applicants requested that the original restriction requirement should be applied, in which case, the compounds of Group I (i.e., formulae 5.1, 5.2, 5.3A, and 5.3B) would be elected with traverse. Applicants argued that the compounds of formulae (5.0), (5.1), (5.2), and (5.3) have the tricyclic ring as the common structural feature. However, the tricyclic ring alone does not define the invention. Note, even the tricyclic ring itself varies as "a", "b", "c" or "d" represents -N-. Thus, depending on the position of the -N- in ring I, the tricyclic ring represent a different group of compounds. Furthermore, ring IV varies from a **piperidinyl** to a **piperazinyl** ring. Therefore, the combination of the tricyclic ring with either a piperidinyl or piperazinyl ring sets apart the inventions of group I and II presented in the parent application 08/ 410,187.

As per applicants' request, the election of group I of the original restriction in application 08/ 410,187 is considered. However, the examiner cannot withdraw such a restriction since it was made final in the application 08/ 410, 187, and was never petitioned.

Claims 1-12, and 22-27 have been cancelled; leaving only claims 13-21 for consideration.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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1. Claims 13-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a. Claim 13 recites variable X and its definition. However, none of the formulae has variable X. Thus, it is unclear as to the relationship of X with respect to formulae (5.0), (5.1), (5.2), (5.3), (5.3A), and (5.3B).
- b. Claims 14-17 are dependent on claim 13. However, it is unclear which formula those claims refer to.
- c. Claim 20 recites compounds by their formula numbers which are confusing since those formula numbers are not listed in the specification by any order. The MPEP requires that chemical compounds to be presented by either chemical names or structures.
- d. Claims 18, 19, and 21 are rejected as being dependent on either claim 13 or 17.

### ***Double Patenting***

2. The **nonstatutory double patenting** rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 13-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of **U.S. Patent No. 6,365,588 B1**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds recited in claims 1-9 of US'588 fall within the genus of formula (5.0) recited in the instant claim 13, and read on species in instant claim 20 (e.g., compounds of (5.17), (5.18), (5.19), (5.20), (5.21), etc.). The compounds of formulae (5.1), (5.2), (5.3), (5.3A), and (5.3B) are not claimed in US'588. However, US'588 does not claim the compounds of claim 20 that are of the formulae of 5.66, 5.68, 5.72, 5.75-5.77, 5.82-5.91, 5.108-5.210, 5.212-5.215, 5.217-5.220, compound of Examples 82, and 235.

4. Claims 13-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-43 of **U.S. Patent No. 5,719,148**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds claimed in US'148 fall within the genus of the formulae (5.1), (5.2), and (5.3A) recited in the instant claim 13, and read on compounds in the instant claim 20 such as: compounds of 5.121, 5.122, 5.205, 5.206, 5.209, 5.210, 5.213, 5.218, 5.219, 5.220. However, US'148 does not claim formulae (5.0), (5.1), (5.3), (5.3B), and species thereof as recited in the instant claim 20.

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5. Claims 13-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 5,696,121. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds claimed in US'121 fall within the genus of formula (5.0), and read on the compounds recited in the instant claim 20 such as compounds of 5.202, 5.207, etc. However, US'121 does not claim compounds of formulae (5.1), (5.2), (5.3), (5.3A), (5.3B), and species thereof as recited in the instant claim 20.

***Information Disclosure Statement***

The IDS of 10-08-02 has been partially considered as many of the references cannot be located in earlier applications.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 571-272-0676. The examiner can normally be reached on M-F (~10 am ~ 6:30 pm) starting from February 08<sup>th</sup>, 2004.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. If you are unable to reach Dr. Shah within a 24 hour period, please contact James O. Wilson, Acting SPE of 1624, at 571-272-0661.

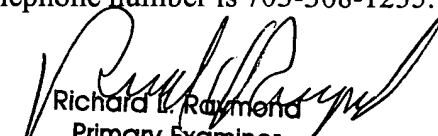
The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



T. Truong

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February 8, 2004



Richard L. Raymond  
Primary Examiner  
Art Unit 1624